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09/833,347

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Rabindranath Dutta

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3791

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EXAMINER

KESACK, DANIEL

ART UNIT

PAPER NUMBER

3691

MAIL DATE

DELIVERY MODE

11/15/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/833,347

Applicant(s)

DUTTA ET AL.

Examiner

Dan Kesack

Art Unit

3691

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12, 16, 17, 19-30, 34-45, 49 and 50 is/are pending in the application.
- 4a) Of the above claim(s) 9-12, 17, 27-30 and 42-45 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-8, 16, 19-26, 34-41, 49 and 50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                 | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. In view of the Appeal Brief filed on July 30, 2007, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

  
ALEXANDER KALINOWSKI  
SUPERVISORY PATENT EXAMINER

### *Status of Claims*

2. Claims 1-8, 16, 17, 19-26, 34-44, 49, and 50 are currently pending. The rejections are as stated below.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 16, 19, and 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, it is unclear what is meant by "transmitting... the transaction result". Applicant's specification does not mention "transaction results", and therefore it is not clear what is intended to be transferred according to the claim language. In addition, the phrase "receiving a check from a user" renders the claim indefinite. It is unclear from the claim language if the check is received from the user (i.e., the user is depositing the check into the ATM), or if the check from the user (i.e., a check written by the user) is simply received.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 1, 5-8, 16, 19, 23-26 and 34, 38-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hyde, Jr., U.S. Patent No. 6,038,553, in view of Cahill et al., U.S. Patent No. 5,678,046, and further in view of Ozaki et al., U.S. Patent No. 5,933,478.

Claims 1, 16, 19, 34, Hyde teaches a system and method of cashing checks without human intervention, comprising receiving a check from a user at an automatic teller machine (column 4 lines 52-57), scanning the check to generate an image (column 5 lines 3-6), transmitting the image to a financial institution data processing system (column 5 lines 3-6), performing a transaction involving the check at the financial institution data processing system to generate a transaction result (column 5 lines 15-23), and transmitting the transaction result to the automatic teller machine (column 6 lines 27-32).

Claims 7, 8, 35, 36, 40, 41, Hyde further teaches capturing an image of a user at an automatic teller machine and stores the information along with both sides of the scanned check within the check cashing database.

Hyde fails to teach transmitting the image of the checks, the image of the user, and the transaction result.

Cahill discloses a system and method for distributing electronic check images to a user. Cahill teaches check images are faxed to a payee's fax machine (column 7 line 64 – column 8 line 5). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Hyde to include faxing the check cashing data captured according to Hyde because Cahill details the reasons it is desirable to archive electronic versions of checks, and the method taught by Cahill is "a significant improvement in the time it takes to prepare correspondence and send it to a payee" (column 8 lines 3-5). It would be an obvious next step to include the user picture which is stored along with the check images because of the security benefits attained by maintaining the user's image. It is noted that in light of the rejection under 35 U.S.C. 112, 2nd paragraph, above, the phrase "transaction results" will be given its broadest reasonable interpretation. As such, Examiner considers the document and check images taught by Cahill to be "transaction results".

Hyde and Cahill fail to teach transmitting the image and the transaction result to a mobile device associated with the user.

Ozaki discloses a system and method for receiving fax image data on a handheld device from a communication server. It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Hyde and Cahill to include receiving the images on a handheld device because such a combination would yield predictable results.

Claims 5, 6, 23, 34, 38, 39, Sending statements to an account holder, as taught by Cahill, is considered sending an alert for the transaction, including identification of the transaction, and the account being updated based upon the transaction result. A statement is known to include transactions completed within the timeframe of the statement. Furthermore, it is old and well known that if the account has multiple names associated therewith, the statement will be sent to all accountholders.

8. Claims 2-4, 20-22, 35-37, 49, and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hyde, Jr., Cahill et al., and Ozaki et al., as cited above, and further in view of "The XML Files".

Hyde, Cahill, and Ozaki fail to teach importing the image and transaction result into an end user financial program.

"The XML Files" discloses receiving a bank statement in a format which is easily imported into bank reconciliation software (p76, column 2, paragraph 3). It would have

been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Cahill to include emailing a bank statement in such a format to the user because providing such a formatted document along with the image of the check makes it more convenient for the user to archive the check information, which is a problem with which Cahill is concerned.

While "The XML Files" does not disclose where the bank reconciliation software is located, Applicant's specification discloses that it is known in the art that bank reconciliation software (Quicken) may be located on mobile devices, as well as other processing system. Furthermore, it is old and well known in the art that data kept on mobile devices such as PDAs may be transferred to a non-mobile device. It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Cahill to include transmitting the received data to another data processing system because it is desirable that a user back up important data such as financial statements.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Kesack whose telephone number is 571-272-5882. The examiner can normally be reached on M-F, 9:00am-5:00pm.



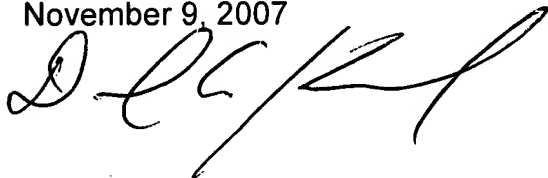
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Respectfully Submitted,  
Daniel Kesack  
Art Unit 3691  
November 9, 2007



ALEXANDER KALINOWSKI  
SUPERVISORY PATENT EXAMINER